

## Attachment E

IN UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Douglas Wilson	Examiner:	Vinh Luong
Serial No.:	10/720,821	Art Unit:	3656
Filing Date:	November 24, 2003		
For:	FATIGUE RELIEVING SUPPORT FOR STEERING WHEELS AND THE LIKE		

Commissioner of Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**AMENDMENT/RESPONSE**

SIR:

**INTRODUCTORY COMMENTS**

This Amendment response to the Office Action dated November 20, 2009. Please amend the above identified U.S. patent applications as follows:

**Amendments to the Claims** are set forth in a listing of the claims which begins on page 2 of this paper.

**Remarks/Arguments** begin on page 4 of this paper.

IN THE CLAIMS:

Claims 1-19 (Cancelled)

20. (Currently Amended) A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising:

a first section that connects to an upper one-half (1/2) of a peripheral portion of the steering wheel; and

a second section that connects to, and extends from, the first section at the peripheral portion of the steering wheel, the second section extends from the first section outward at an angle to a plane across a face to the steering wheel, the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

21. (Original) The apparatus as recited in claim 20, wherein the second section is deformable in at least one direction when deforming pressure is applied to such second section.

22. (Previously Amended) The apparatus as recited in claim 20, wherein the second section provides resting support for a portion of the vehicular operator's body when resting support pressure from such body portion is applied in at least one direction.

23. (Original) The apparatus as recited in claim 20, wherein the steering wheel includes a steering wheel for controlling at least a nautical vessel, an aircraft, or a ground transportation vehicle.

24. (Original) The apparatus as recited in claim 20, wherein the second section will return to an original first position after deforming pressure is removed therefrom.

25. (Original) The apparatus as recited in claim 20, wherein the portion of the body supported by the second section includes at least a forearm, wrist, or hand.

26. (Original) The apparatus as recited in claim 20, wherein the first section extends a length of a predetermined peripheral portion of the steering wheel.

27. (Currently Amended) A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising:

at least a first first section and a second first section that connect to an upper one-half (1/2) of a peripheral portion of the steering wheel; and

at least a first second section and a second second section that connect to, and extends from the first and second first sections, respectively, with the first and second second sections extending from the respective first and second first sections outward at an angle to a plane across a face to the steering wheel, the first and second second sections each providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the first or second second section is less than the pressure for deforming the first or second second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the first or second second section is equal to or greater than the pressure for deforming the first or second second section out of interference with the vehicular operator's ability to operate the steering wheel.

28. (Currently Amended) The apparatus as recited in claim ~~20~~ of 27, wherein the first and second first sections are deformable.

29. (New) The apparatus as recited in claim 20, wherein the first section is deformable.

## REMARKS/ARGUMENTS

### **I. INTRODUCTION**

Claims 20-29 are pending in the present application. This Amendment/Response ("Amendment") is filed to respond to the Office Action dated November 20, 2009. In the Office Action, the Examiner set forth the following objections and rejections related to the specification and claims:

A. the specification is objected to for failing to provide a proper antecedent basis for the claimed subject matter, such as, "a *first* first section"..., "a *second* first section," "a *first* second section," and "a *second* second section" in claim 27. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o);

B. claim 29 (previously 28/20) is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to adequately point out and distinctly claim subject matter which Applicant regards as the invention for reciting the limitation "the first and second first *sections*" (plural, emphasis) and claim 20 recites "a first *section*" (singular, emphasis);

C. claims 20-26 and 29 are rejected under 35 U.S.C. § 102(b) for anticipation based on U.S. Patent No. 2,134,020 to Anson ("Anson");

D. claims 27 and 28 (previously 28/27) are rejected under 35 U.S.C. § 103(a) for obviousness based on Anson taken with or without U.S. Patent Pub. No. 2002/0162416 to Gemma (cited in the European Search Report);

E. claims 20 and 27, and claim 28 (previously 28/27) are rejected under 35 U.S.C. § 102(b) for anticipation based on Gemma;

F. claim 20 is rejected under 35 U.S.C. § 102(b) for anticipation based on U.S. Patent No. 5,207,713 to Park ("Park");

G. claims 20-26 and 29 (previously 28/20) are provisionally rejected under the judicially created doctrine of obviousness-type double patenting based on claims 14-17, 24, and 27 of co-pending Application No. 10/727,306 (the "306 Application"); and

H. claims 27 and 28 (previously 28/27) are provisionally rejected under the judicially created doctrine of obviousness-type double patenting based on claims 18 and 19/18 of the 306 Application.

Applicant will demonstrate that the claims, as amended, overcome the objection and each of the bases of rejection advanced by the Examiner, thereby, placing in the present application in condition for allowance.

## II. LEGAL STANDARD

As stated in Section I, the Examiner has rejected claims 20-26 and 29 for anticipation under 35 U.S.C. § 102(b) based on Anson; claims 20, 27, and claim 28 for anticipation under 35 U.S.C. § 102(b) based on Gemma; and claim 20 for anticipation under 35 U.S.C. § 102(b) based on Park. The Examiner also rejected claims 27 and 28 for obviousness under 35 U.S.C. § 103(a) based on Anson taken with or without Gemma.

The standard for sustaining a rejection for anticipation is a single prior art reference must disclose each and every limitation of the claim. *See, e.g., Schering Corp. v. Geneva Pharma., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (“[a] patent [claim] is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention”); *Trintec Industries, Inc. v. Top-USA Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (“[a] single prior art reference anticipates a patent claim if it expressly or inherently describes each and every limitation set forth in the patent claim.... Inherent anticipation requires that the missing descriptive material is ‘necessarily present,’ not merely probably or possibly present, in the prior art”); *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001) (“[t]o anticipate, every limitation of the claimed invention must be found in a single prior art reference, arranged as in a claim”); *Kloster Speedsteel AB v. Crucible, Inc.*, 794 F.2d 1565, 1571 (Fed. Cir. 1986) (“absent from the reference of any claimed element negates anticipation”). Neither Anson, Gemma, nor Park meets this standard.

The standard for sustaining a rejection for obviousness is different if the rejection is based on a single reference or multiple references. In general, to sustain an obviousness rejection based on a single reference or multiple references, the rejection must be based on

inquiries according to *Graham v. John Deere*, 383 U.S. 1, 17 (1966). The inquiries are (1) the scope and content of the prior art, (2) differences between the prior art and the claims at issue, and (3) the level or ordinary skill in the pertinent art. Based on these inquiries, the Examiner must establish a *prima facie* obviousness rejection based on one or more references, which can be rebutted by the applicant. In considering the prior art for the purpose of establishing an obviousness rejection, a *prima facie* case for obviousness is established when the teachings of the prior art would appear to suggest the claimed invention to a person of ordinary skill in the art, but is not established when the claimed subject matter is speculative (*See, In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (“The mere fact that a certain thing *may* result from a given date of circumstances is not sufficient [to establish inherency]...”). If obviousness is based on a combination of references, there must be some teaching, suggestion, or motivation found for the combination. *Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc.*, 344 F.3d 1186, 1196 (Fed. Cir. 2003) (“When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation for combining these references.”). Applicants submit that these standards have not been met in rejecting the claims for obviousness based on Anson taken with or without Gemma.

### III. THE SPECIFICATION SUPPORTS CLAIM 27

The Examiner has objected to the specification for allegedly failing to provide a proper antecedent basis for claimed subject matter such as, “a *first* first section”..., “a *second* first section,” “a *first* second section,” and “a *second* second section” in claim 27. The Examiner in asserting this objection cites 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Applicant submits that the specification supports the claim language objected to by the Examiner at least at paragraphs [0021]-[0025]. The specification states the following at these paragraphs:

[0021] In FIG. 2, generally at 200, steering control 211 has two systems of the present invention associated with it. The first is shown at 202 and the second at 203. The first and second systems in FIG. 2, extend over a smaller arc of the steering control compared to the single system shown in FIG. 1.

[0022] The first system of the present invention at 202 includes first section 204 [first first section] that connects to steering control 211 and second section 205 [first second section] that extends outward from first section 204. First section 204 may be rigid, semi-rigid, or deformable, while second section 205 is deformable. If the first section is deformable, it may have memory.

[0023] Similarly, the second system of the present invention at 203 includes first section 207 [second first section] that connects to steering control 211 and second section 209 [second second section] that extends outward from first section 207. First section 207 may be rigid, semi-rigid, or deformable, while second section 209 is deformable. Again, if the first section is deformable, it may have memory.

[0024] In FIG. 2, system 202 is at or near the ten o'clock position and system 203 is shown at or near the two o'clock position. Although, the two systems have been described as being positioned at the ten and two o'clock locations, it is understood that they may be placed at other locations around the rim and there may be more than two systems and still be within the scope of the present invention.

[0025] Referring to FIGS. 1 and 2, first section 103 in FIG. 1, and first sections 204 and 207 in FIG. 2, may be formed integral with steering control 105 and 211, respectively....

As demonstrated in the quotation above, the specification at paragraphs [0021]-[0025] specify that there can be two systems associated with a steering wheel. Each of these systems would have a first section and a second section. Therefore, for purposes of claiming, in order to differentiate the two systems, it is necessary to refer to them as a "first first section" and a "first second section" that apply to the first system and a "second first section" and a "second second section" that apply to the second system. Accordingly, Applicant has traversed the Examiner's objection to the specification and request that it be withdrawn.

#### **IV. CLAIM 28 IS A DEFINITE**

The Examiner rejected claim 28/20 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to adequately point out and distinctly claim subject matter which Applicant regards as the invention for reciting the features "the first and second first sections" (plural, emphasis) and claim 20 recites "a first section" (singular, emphasis). Herein, Applicant has



amended claim 28 to depend only from claim 27. As such, by deleting the multiple dependency, claim 28 overcomes the Examiner's basis of rejection.

Applicant has also added new claim 29 (previously 28/20) which recites that the "first section is deformable." There is no support for the Examiner to raise an indefiniteness rejection with regard to claim 29 since claim 29 depends only from claim 20.

Noting the foregoing, the Examiner should withdraw the indefiniteness rejection that has been applied to claim 28.

**V. CLAIMS 20-26 AND 29 ARE NOVEL IN VIEW OF ANSON**

The Examiner rejected claims 20-26 and 29 (previously 28/20) under 35 U.S.C. § 102(b) for anticipation based on Anson. The description of the Anson attachment on which the Examiner relies in rejecting these claims for anticipation has been expanded from previous rejections in the prosecution history of the present application. At present, the Examiner is relying on substantially all of page 1 and a small portion of page 2 of Anson to allegedly support his rejection. The following table shows the portions of pages 1 and 2 of Anson on which the Examiner relies.

<u>CLAIM</u>	<u>RELIANCE IN ANSON</u>
20	Page 1, Left Column, Line 6 -- Right Column, Line 53
21	Page 1, Right Column, Lines 50-53
22	Page 1, Left Column, Lines 1-43
23	No citation
24	Page 1, Right Column, Lines 50-53
25	No citation
26	No citation
29 (amended 28/20)	Page 2, Left Column, Lines 35-72

Given this broad citation to Anson by the Examiner shown in the table above, Applicant provides the following portions of Anson that he submits are germane in responding to the Examiner's rejection of claims 20-26 and 29. The general problem that is allegedly solved by Anson is the following:

I [Anson] have found that in the driving of an automobile and particular when driving for extended periods of time over long distances, the normal manner of holding and manipulating the steering wheel, wherein both driver's hands grasp the wheel and positions which require the driver's arms remain in a raised and more or less unnatural and uncomfortable position, considerable strain develops in the driver's hands, arms, shoulders and back particularly, and results in excess of fatigue...

To obviate these disadvantages, I have devised an attachment for steering wheel, which permits a driver to assume a completely comfortable and relaxed driving position, while at the same time, affords a means permitting the driver to at all times retain positive operating control of the steering wheel.

To this end, I have devised an attachment which comprises generally an auxiliary grip handle is attachable to a steering wheel and extends from the wheel so that it permits the driver to grasp the handle with one hand while that hand is resting in a completely relaxed position in his lap.... My new attachment is preferably construction of a rubber or similar composition material which is sufficiently resilient to be comparably gripped by the hand and sufficiently pliable to yield readily to pressure of contact with more or less solid structures, such as the body or legs of the driver, but which is characterized by sufficient rigidity to afford a positive means of control or manipulation of the wheel by the driver.

Therefore the general object of the invention is to provide an attachment for relieving strain resulting from the normal method of steering automobiles while driving long distances.

A principal object is to provide an improved flexible... steering grip... which will permit the driver to remove his hands from the wheel and allow them to be positioned in a comfortable and relaxed position while enabling adequate steering of the car to be had with one hand, leaving the other hand free for signaling purposes or for purposes of complete rest and relaxation.

\* \* \*

Referring to the drawing and Figs. 1 and 2 in particular, the steering attachment of this invention is shown attached in the normal driving position to a steering wheel 10. The attachment comprises a handgrip portion 11, which is

preferably of bulbular form and constructed of a flexible material such as rubber or a similar pliable composite material. [Emphasis added.]  
Anson, Page 1, Left Column, Line 6 -- Right Column, Line 53.

Applicant also would like to bring to the Examiner's attention to the following quotation from the Pages 1 and 2 that focuses on a proper understanding of the alleged invention of Anson:

The attachment comprises a hand grip portion 11, which is preferably of bulbular form.... Grip portion 11 normally extends downwardly from the wheel rim and is of suitable length to adapt same to extend to the region of the driver's lap so that it may be grasped by the driver's hand when his hand is resting in a normal comfortable position in his lap. Grip portion 11 is reduced in cross-sectional area at one end to form a neck 12. Neck 12...will have sufficient pliability...to be deflected from its normal pendant position without adversely affecting the measure of control of the steering wheel movements afforded by the positive operating movement of the attachment, while at the same time, neck 12 will retain sufficient rigidity to permit operating movements of hand grip 11 to be positively communicated to the steering wheel rim for effective control of its movements.

Anson, Page 1, Right Column, Line 49 – Page 2, Left Column, Line 18.

Of the claims of the present application rejected for anticipation based on Anson, claim 20 is an independent claim and claims 21-26 and 29 depend from claim 20. Claim 20, as amended, recites the following:

20. A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising:

a first section that connects to an upper one-half (1/2) of a peripheral portion of the steering wheel; and

a second section that connects to, and extends from, the first section at the peripheral portion of the steering wheel, the second section extends from the first section outward at an angle to a plane across a face to the steering wheel, the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for

deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. [Emphasis added.]

As shown in the quotation above, the apparatus of the present invention is disposed on the upper one-half (1/2) of the steering wheel, which is supported by Figures 1 and 2 of the present application, and the "second section" provides resting support for the vehicle operator's arm(s), wrist(s), etc.

Figure 8 of Anson shows the normal position for the steering wheel attachment. This is a pendant position at the bottom of the steering wheel. Anson clearly states in the quotation above that the problem to be allegedly solved is eliminating the problems associated with steering the vehicle with the driver's hands at the normal 10:00 and 2:00 positions (Anson, Page 1, Left Column, Lines 6-18 and Lines 44-47). This solution is allegedly accomplished by moving steering to the bottom of steering wheel using the attachment (Page 1, Right Column, Line 46 - Page 2, Left Column, Line 4). Claim 20, as amended, recites the apparatus of the present invention is disposed on the upper one-half (1/2) of the steering wheel periphery. This provides a structural difference between Anson and the present invention.

According to Anson, the attachment is not usable when placed at the upper one-half (1/2) of the periphery of the steering wheel. This is supported by Anson at Page 2, Right Column, lines 68-72, where it states:

Similarly, the attachment may be rotated about the steering wheel rim from its normal pendant position to a position within the periphery of the steering wheel when it becomes desirable to dispense with its use in operating the wheel.

According to the quotation immediately above, a steering wheel attachment of Anson will be moved to the upper one-half (1/2) of the steering wheel so that it will extend within the periphery when it is no longer desirable to be used for steering the vehicle. Accordingly, the steering wheel attachment of Anson is inoperable when located at the upper one-half (1/2) of the steering wheel.

Applicant also submits that Anson does not provide resting support for the vehicle driver's hands as asserted by the Examiner. More specifically, the bulbular-formed grip portion 11 does not provide "resting support" for the driver's body; that is provided by the driver's lap.

Applicant's position in this regard is supported at least in two sections of Anson. The first is found at Page 1, Right Column, Line 49 -- Page 2, Line 18, which was previously quoted in this Amendment at Page 9. The second is at Page 2, Right Column, Lines 49-56, which states:

From the foregoing it will be evident that by means of any one of the described modifications of my new steering wheel attachment, the ordinary steering wheel movements may be completely controlled with one hand by the driver while that hand is in a comfortably supported position in the driver's lap, the other hand being free for purposes of signaling or repose. [Emphasis added.]

The "resting support" issue will be addressed in greater detail in Section X of this Amendment.

Noting the foregoing, Anson does not support the Examiner's basis for rejecting claim 20 and this rejection should be withdrawn.

Claims 21-26 and 29 depend from claim 20. As such, each of these claims adds features to claim 20. Therefore, since claim 20 is not anticipated by Anson, then claims 21-26 and 29 are not anticipated by Anson for at least the same reasons. As such, Applicant has traversed the Examiner's anticipation rejection based on Anson as applied to claims 20-26 and 29. Applicant requests that this rejection be withdrawn.

#### **VI. CLAIM 27 AND 28 ARE NONOBVIOUS IN VIEW OF ANSON COMBINED WITH OR WITHOUT GEMMA**

The Examiner rejected claims 27 and 28 under 35 U.S.C. § 103(a) for obviousness based on Anson taken with or without Gemma. Claim 27 is an independent claim and claim 28 depends from claim 27. As amended, claim 27 states:

27. (Currently Amended) A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising:

at least a first first section and a second first section that connect to an upper one-half (1/2) of a peripheral portion of the steering wheel; and

at least a first second section and a second second section that connect to, and extends from the first and second first sections, respectively, with the first and second second sections extending from the respective first and second first sections outward at an angle to a plane across a face to the steering wheel, the first and second second sections each providing resting support for at least a portion of

a vehicular operator's body when pressure from the portion of the vehicular operator's body on the first or second second section is less than the pressure for deforming the first or second second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the first or second second section is equal to or greater than the pressure for deforming the first or second second section out of interference with the vehicular operator's ability to operate the steering wheel.

With regard to the obviousness rejection based on Anson alone, the Examiner states (Office Action, page 5, paragraph 8):

Anson teaches the invention substantially as claimed. However, Anson teaches one first deformable section 13 and one deformable second section 11.

It would have been obvious to one having ordinary skill in the art to change Anson's one deformable first section to at least two deformable first sections (*i.e.*, the first first section and the second first section) and Anson's one second section to at least two second sections (*i.e.*, the first second section and the second second section) in order to relieve fatigue to the vehicle operator as taught or suggested by common knowledge in the art. The number of deformable first sections and second sections would have been a matter of choice in design since the claimed structures and the function they perform are the same as the prior art. [Citations omitted.]

Applicant submits the Examiner's conjecture with regard to there being a plurality of steering wheel attachments in Anson (a design choice) is misplaced given the specific disclosure of Anson.

Anson provides no teaching or suggestion of there being other than one steering wheel attachment associated with a steering wheel. Moreover, there are specific statements in Anson that plainly indicate the intent of the invention is to have just one. At Page 1, Left Column, Line 48 to Page 1, Right Column, Line 4, it states:

A principal object is to provide an improved flexible but semi-rigid, steering grip which can readily be attached to, or removed from, any steering wheel... which will permit the driver to remove his hands from the wheel and allow them to be positioned in a comfortable and relaxed position while enabling

adequate steering of the car to be had with one hand, leaving the other hand free for signaling purposes and for purposes of complete rest and relaxation.

Similarly, in Anson at Page 2, Right Column, Lines 49-56, it states:

From the foregoing it will be evident that by means of any one of the described modifications of my new steering wheel attachment, the ordinary steering wheel movements may be completely controlled with one hand by the driver while that hand is in a comfortably supported position in the driver's lap, the other hand being free for purposes of signaling or repose.

According to the above quotations from Anson, there is no reasonable basis for the Examiner to advance that there would be more than one steering wheel attachment connected to steering wheel. Further, by the Anson steering wheel attachment being pliable, if there were multiple steering wheel attachments (one for each hand), it could adversely affect the ability to control the car. For example, there could be the entanglement of the attachments in trying to steer the vehicle with two very flexible attachments. The Examiner has not pointed to any statements in Anson to support his position that there would be more than one Anson steering wheel attachment only support that clearly teaches away.

In rejecting claim 27 under 35 U.S.C. §103(a) for obviousness based on Anson in view of Gemma, the Examiner states the following:

Alternatively, Gemma teaches at least two deformable first sections (*i.e.*, the first first section and the second first section connected to the rim/peripheral portion 14 of the steering wheel 12, see Appendix 2 ... and Gemma, ¶¶ 24-26) and at least two second sections (*i.e.*, the first second section 16, 26 and the second second section 16, 26 squeezed by the vehicle operator) in order to relieve fatigue to the vehicle operator. Gemma, Summary of the Invention.

It would have been obvious to one having ordinary skill in the art to change Anson's one first section to at least two first sections and Anson's one second section to at least two second sections in order to relieve fatigue to the vehicle operator as taught or suggested by Gemma. The modification of Anson's apparatus by changing the number of the first and second sections as taught or suggested by Gemma would not have been uniquely challenging to a person of ordinary skill in the art because it is no more than "a simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement." [Citation omitted.] [Emphasis added.]

Applicant first asserts that Gemma is improperly combined with Anson given that Anson is directed to fatigue relief (Anson, Page 1, Left Column, lines 6-18), while Gemma is directed to stress relief (Gemma, paragraph [0007]). There is such a substantial difference between the intent of Anson and Gemma that it would be improper for the Examiner to combine the teachings of Anson and Gemma.

In order for two or more references to be combined for the purposes of an obviousness rejection there must be some teaching, suggestion or motivation within for such a combination. Applicant submits there is no teaching, suggestion or motivation for combining Gemma with Anson.

In Anson at Page 1, Right Column, lines 5-10, it states:

In practice, it is found that an auxiliary grip attachment constructed of a rubber composition, which has a hand grip portion in the form of a hollow bulb, shaped to fit the hand, is particularly adapted to comfortable and non-fatiguing gripping by the hand of the driver. [Emphasis added.]

As demonstrated in the quotation above, the structure of the Anson attachment is held in a non-fatiguing manner.<sup>1</sup> Gemma, on the other hand, states the following at paragraph [0027]:

Regardless of the type of stress relief steering wheel cover that is employed, the use remains the same. While driving and experiencing stress, the driver would place his or her hands around the cover 10 and squeeze tightly. It would be found that this type of release of energy can reduce the level of stress, along with the emotional response associated therewith. [Emphasis added.]

The two quotations immediately above demonstrate that Gemma teaches away from Anson. In Anson, the grip attachment is held in a non-fatiguing manner, which is not "squeezing" the grip attachment to relieve stress. There is no teaching or suggestion in Anson that the grip attachment relieves stress. The two sacs at 10:00 and 2:00 on the Gemma steering wheel cover and Gemma are meant to be squeezed tightly for the purpose of stress relief. There is no teaching or suggestion in Gemma that the stress relief provides any type of fatigue relief.

<sup>1</sup> Although Applicant has cited to Anson regarding the driver holding the grip attachment in a non-fatiguing manner, Applicant still contends that the grip attachment as held by the hand does not provide resting support. As clearly spelled out in Anson, resting support is provided by the driver's lap.



Although the Examiner states Gemma provides "fatigue relief" in the obviousness rejection support, there is nothing in Gemma to support this position by the Examiner.

As Applicant demonstrated in Section V, the clear and only intent in Anson is to have a single grip attachment and not multiple grip attachments, *i.e.*, one for each hand. The pliability of the Anson attachment is not conducive to having more than one grip attachment as described above. One of ordinary skill in the art reading Anson and Gemma would recognize these differences and would not find any teaching, suggestion or motivation to support the Examiner's contention that there would be multiple Anson grip attachments according to Gemma.

Noting the above, the Examiner has improperly combined Anson with Gemma given (i) the teachings and suggestions in Anson and Gemma are completely different in that Anson is directed to fatigue relief when the grip attached is used while Gemma is directed to stress relief caused by squeezing the sacs of the steering wheel cover tightly and (ii) there is no teaching, suggestion, or motivation in Anson that there should be more than one grip attachment per Gemma given the pliability of the material used for the Anson grip attachment. As such, Applicant has traversed the Examiner's rejections of claim 27 for obviousness based on Anson alone or Anson in view of Gemma.

Claim 28 depends from claim 27 and, as such, add features to claim 27. Therefore, since claim 27 is not rendered obvious by Anson alone or Anson in view of Gemma, then claim 28 also is not obvious in view of these references taken alone or in combination for at least the same reasons. As such, Applicant has traversed the Examiner's obviousness rejections applied to claims 27 and 28. Applicant, therefore, requests that these obviousness rejections be withdrawn.

#### **VII. CLAIMS 20, 27, AND 28 ARE NOVEL IN VIEW OF GEMMA**

The Examiner rejected claims 20, 27, and 28 under 35 U.S.C. § 102(b) for anticipation based on Gemma. Of these claims, claims 20 and 27 are independent claims, and claim 28 depends from claim 27. In rejecting claims 20 and 27, the Examiner contends that Gemma teaches a fatigue relieving/preventing apparatus. Applicant submits that the Examiner's contention that Gemma teaches a fatigue relieving/preventing apparatus is misplaced.

As demonstrated in Section VI of this Amendment, Gemma is directed to stress relief. The sacs of the steering wheel cover are held by the driver and tightly squeezed when necessary to relieve stress. (See paragraph [0008]). When it is not necessary to relieve stress, the sacs are not held and squeezed. Whether held or not, the sacs of the steering wheel cover do not provide fatigue relief as the Examiner contends. The Examiner has failed to support the anticipation rejection based on Gemma with any citations to Gemma where it states this reference provides fatigue relief.

Claims 20 and 27 with respect to the second section states:

a second section that connects to, and extends from, the first section at the peripheral portion of the steering wheel, the second section extends from the first section outward at an angle to a plane across a face to the steering wheel, the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. [Emphasis added.]

With respect to teaching the second section of the claims 20 and 27, the Examiner cites paragraphs [0008], [0024], and [0026] of Gemma. These three paragraphs state:

[0008] To attain this, the present invention essentially comprises a stress relief steering wheel cover attached to the rim of a steering wheel. The covers are composed of sac assemblies mounted onto the steering wheel. The sac assemblies are comprised of outer and inner layers with particulate material situated in between. The outer layer is made out of a soft cushion material. The covers are generally "C" shaped, having a narrow opening along one side to allow the cover to be fitted around the steering wheel. A strip of hook and loop fasteners is attached at each end of the opening and serves to fasten the cover around the steering wheel. Alternatively, the stress relief covers may be incorporated directly into the steering wheel. While driving and experiencing stress, the driver would place his or her hands around the covers and squeeze tightly in order to reduce his or her stress level.

[0024] The covers 10 are composed of sac assemblies mounted onto the steering wheel 12. The sac assemblies are comprised of outer and inner layers 16, 18, respectively. The outer layer 16 extends around the entire cover 10 and secures the contents of the inner layer 18 therein. The outer layer 16 defines a compartment housing particulate material 20, namely seeds, pebbles, silicon or the equivalent which are often use in other stress relief devices. The outer layer 16 is made out of a soft flexible material, such as rubber. Such a material would provide a driver with a soft gripping area, conducive to the relief of stress while driving.

[0026] In an alternate embodiment, the stress relief covers 10 may be incorporated directly into the steering wheel 12. This may be accomplished by incorporating the particulate material 20 directly between the outer layer 16 and the rim 14 of the wheel 12 or spokes 24 contained within the rim 14 of the steering wheel 12, as seen in FIG. 2 or FIG. 4. In this embodiment, bulges 26 situated strategically around the rim 14 of the wheel or the entire spoke 24 comprise the layers described above. When stressed, a driver would place his or her hands around one or more of the spokes 24 or bulges 26 and squeeze in order to relieve stress.

A review of paragraphs [0008], [0024], and [0026] relied on by the Examiner, however, demonstrates Gemma does not teach or suggest at least the following of claims 20 and 27:

the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. [Emphasis added.]

Nothing in Gemma provides for the deforming of the sacs out of interference with the operation of the steering wheel, only that the sacs are squeezed to relieve stress. Therefore, Gemma does not teach or suggest fatigue relief as the Examiner contends, nor does Gemma teach or suggest the sacs will deform out of interference with the operation of the steering wheel. As such, Applicant has demonstrated that Gemma does not anticipate claims 20 and 27.

Claim 28 depends from claim 27. As such, claim 28 adds features to claim 27. Therefore, since claim 27 is not anticipated by Gemma, then claim 28 is not anticipated by

Gemma for at least the same reasons. Applicant has traversed the Examiner's anticipated rejection based on Gemma as applied to claims 20, 27, and 28. Applicant requests that this anticipation rejection be withdrawn.

### VIII. CLAIM 20 IS NOVEL IN VIEW OF PARK

The Examiner rejected claim 20 under 35 U.S.C. § 102(b) for anticipation based on Park. Park is directed to a steering wheel safety cover that to a limited degree prevents injuries to the driver if the driver impacts the steering wheel. The safety cover has an inflatable cavity on the side of the steering wheel facing the driver. The cavity may be filled with air, a liquid, or a solid elastic material. The safety cover wraps around the outer circumference of the steering wheel. To support the Examiner's anticipation rejection, he cites claims 1-15 of Park as anticipating the second section of claim 20. Claims 1-15 state:

1. A safety cover adapted for use with a steering wheel having a generally circular handgrip portion, comprising:
  - (a) an annular impact reducing portion (20) adapted for concentric arrangement about said handgrip portion; and
  - (b) a mounting portion (60) operable to mount said impact reducing portion to said handgrip portion;
  - (c) said impact reducing portion including a partition wall portion (21) integral with said mounting portion, said partition wall portion containing a chamber (22) for receiving an impact reducing material (24).
2. A safety cover as defined in claim 1, wherein said impact reducing material is air.
3. A safety cover as defined in claim 1, wherein said impact reducing material is a liquid.
4. A safety cover as defined in claim 1, wherein said impact reducing material is a solid elastic material.
5. A safety cover as defined in claim 1, wherein said mounting portion is annular and contains an annular groove for receiving said steering wheel handgrip portion; and further including mounting wire means (25) imbedded within the edges of, and extending parallel with, said groove.
6. A safety cover as defined in claim 1, and further wherein said mounting portion is integral with said impact reducing portion and includes an

annular protruding portion that extends within a corresponding recess (1a) contained in said steering wheel.

7. A safety cover as defined in claim 6, and further including an outer leather sheet cover layer arranged concentrically about, and adhesively bonded to, said impact reducing portion, and string means extending around said steering wheel for connecting together the edges of said leather sheet cover layer, thereby to retain said safety cover on the steering wheel.

8. A safety cover as defined in claim 1, wherein said impact reducing partition wall portion includes;

- (1) an annular air tube (21b);
- (2) a layer of reinforcing cloth (30) arranged around the circumference of said air tube; and
- (3) a layer of leather (41) arranged around the circumference of said cloth layer.

9. A safety cover as defined in claim 8, and further wherein said leather layer is adhesively bonded to said cloth layer and includes an end portion connected by a line of sewing (42) with a mid portion thereof.

10. A safety cover as defined in claim 8, wherein said layer of leather is sewn at one edge by a line of sewing (42) with a wing portion (20) of said air tube, said leather layer extending circumferentially around said air tube and partially around the circumference of said steering wheel handgrip portion, and further including a string (28) mounted in the other edge portion of said leather layer, the ends of said string being exposed.

11. A safety cover as defined in claim 8, and further wherein circumferentially spaced portions of said air tube are bonded together by high frequency energy to define a plurality of independent air pockets 22b.

12. A safety cover as defined in claim 1, wherein said mounting portion includes:

- (1) a layer of reinforcing cloth (30) extending concentrically about said partition wall portion;
- (2) a layer of leather (41) wrapped around said partition wall portion and including a hem portion extending partially around the steering wheel handgrip a hem portion extending partially around the steering wheel handgrip portion, thereby to define said mounting portion; and
- (3) a string element (28) mounted on the free edge of said leather layer hem portion for tying said leather layer to the steering wheel.

13. A safety cover as defined in claim 1, and further including means for inflating said chamber with air, including: (1) an air pump (52); and (2) an air hose (51) connecting said air pump with said air tube.

14. A safety cover as defined in claim 13, wherein said inflating means further includes an air valve (58) connected with said air tube, and an injecting needle (59) connecting said air hose with said air tube via said air valve.

15. A safety cover as defined in claim 1, wherein said partition wall contains a plurality of air holes (23).

A review of claims 1-15 demonstrates Park does not teach or suggest at least the following of claim 20 other present application:

the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. [Emphasis added.]

Nothing in Park provides for the deforming of the sacs out of interference with the operation of the steering wheel. All that is provided is an inflatable cavity that will give the driver some level of impact protection. Further, Park does not teach or suggest fatigue relief as the Examiner contends. As such, Applicant has demonstrated that Park does not anticipate claim 20.

Applicant has traversed the Examiner's anticipation rejection based on Park as applied to claim 20. Applicant requests that this anticipation rejection be withdrawn respect to claim 20.

#### **IX. THE OBVIOUSNESS-TYPE DOUBLE PATENTING REJECTIONS SHOULD BE WITHDRAWN**

##### **A. Claims 20-26 and 29**

The Examiner has provisionally rejected claims 20-26 and 29 under the judicially created doctrine of obviousness-type double patenting in view of claims of 14-17, 24, and 27 of co-pending Application No. 10/727,306 ("306 Application"). In the 306 Application, the Examiner

rejected the claims based on the judicially created doctrine of obviousness-type double patenting in view of the claims of the present application. In response to that rejection, Applicant filed a terminal disclaimer in the 306 Application that has been accepted by the Examiner and the obviousness-type rejection was withdrawn in the 306 Application.

The acceptance by the Examiner of the terminal disclaimer in the 306 Application will mean that the patent terms of the present application and 306 Application have already been tied to each other. Accordingly, Applicant submits that in light of the terminal disclaimer being filed and accepted with respect to the 306 Application, it is improper to file a terminal disclaimer in the present application as suggested by the Examiner. Accordingly, Applicant requests that this rejection be withdrawn with respect to claims 20-26 and 29.

**B. Claims 27 and 28**

The Examiner has provisionally rejected claims 27 and 28 under the judicially created doctrine of obviousness-type double patenting in view of claims of 18 and 19/18 of the co-pending 306 Application. In the 306 Application, the Examiner rejected the claims based on the judicially created doctrine of obviousness-type double patenting in view of the claims of the present application. In response to that rejection, Applicant filed a terminal disclaimer in the 306 Application that has been accepted by the Examiner and the obviousness-type rejection was withdrawn in the 306 Application.

The acceptance by the Examiner of the terminal disclaimer in the 306 Application will mean that the patent terms of the present application and 306 Application have already been tied to each other. Accordingly, Applicant submits that in light of the terminal disclaimer being filed and accepted with respect to the 306 Application, it is improper to file a terminal disclaimer in the present application as suggested by the Examiner. Accordingly, Applicant requests that this rejection be withdrawn respect to claims 27 and 28.

**X. ANSON, GEMMA, AND PARK DO NOT PROVIDE RESTING SUPPORT**

At numbered paragraph 14 on page 11 of the Office Action, the Examiner seeks to refute Applicant's position the steering wheel attachment of Anson does not provide resting support.

Applicant submits that neither Anson nor Gemma and Park teach, suggest, or render obvious resting support according to the claims of the present invention.

The Examiner has rejected claims 20-26 and 29 for anticipation under 35 U.S.C. § 102(b) based on Anson, claims 20 and 27, and claim 28 for anticipation under 35 U.S.C. § 102(b) based on Gemma, and claims 20 for anticipation under 35 U.S.C. § 102(b) based on Park. The Examiner also rejected claims 27 and 28 for obviousness under 35 U.S.C. § 103(a) based on Anson taken with or without Gemma. In each of these grounds of rejection, the Examiner has advanced Anson, Gemma, and Park either anticipate or render obvious the feature of “resting support” being provided by the present invention. Applicant, however, submits that this is not true, and at least with respect to Anson was recognized as a distinguishing feature between the claims of present invention and Anson by the Board of Patent Appeals and Interferences.

In the Office Action, the Examiner at Page 12 acknowledges that functional features of an apparatus claim can distinguish the claim from prior art cited by the Examiner. With regard to Anson, the Examiner argues that “resting support” is an inherent feature of the Anson attachment. This position of the Examiner is predicated on the Anson attachment being bulbular in shape and being gripped by the driver’s hand. The Examiner attempts to support the contention Anson provides a “resting support” by quoting a definition of the term “rest” from the *Merriam-Webster’s Collegiate Dictionary*. Then, the Examiner makes the unnatural extension of this by stating when the driver places his hand on the bulbular portion, the driver rests his hand on that portion. Next, the Examiner makes a conclusory statement unsupported by Anson that “[s]imply put, Anson’s second section inherently provides resting support for at least the hand, *i.e.*, the portion of the vehicle upper’s body as claimed.” The Examiner takes his position despite evidence in Anson to the contrary.

Anson at Page 1, Right Column, Line 53 -- Page 2, Left Column, Line 4 states:

Grip portion 11 normally extends downwardly from the wheel rim and is of suitable length to adapt same to extend to the region of the driver’s lap so that it may be grasped by the driver’s hand when his hand is resting in a normal comfortable position in his lap.



In unequivocal language, Anson specifically describes "resting support" being provided by the driver's lap and not by the Anson attachment. The Examiner's parsing of the words "resting support" to first describe the word "rest" based on a dictionary definition and then attempt in a conclusory manner to expand the definition of "rest" to "resting support" is clearly improper. This is especially inappropriate given Anson describes "resting support" with regard to the Anson attachment within the four corners of Anson.

The fact the Anson attachment did not provide "resting support" was recognized by the Board of Patent Appeals and Interferences in the Oral Hearing Transcript at pages 14-16.<sup>2</sup> The Examiner appears to not recognize this position of the Board.

Further, the grasping of the Anson attachment for purposes of control of the vehicle would require that the driver squeeze and hold the bulbular section 11. By grabbing and holding the bulbular section, there would not be any inherent resting support provided to the driver. Accordingly, this is another basis by which it would be understood that Anson does not provide resting support as the Examiner contends.

Section VII of this Amendment describes the alleged invention of Gemma as a "C" shaped steering wheel cover with stress relief sacs that are squeezed by the driver for stress relief during vehicle operation. When the sacs are squeezed, they are not providing fatigue relief; and when the sacs are not in use, there is nothing to indicate within the four corners of Gemma that they provide any type of fatigue relief. Moreover, there is nothing inherent about the sacs that would indicate they would provide fatigue relief and be deformable out of interference with the operation of the steering wheel as claimed in the present application.

Section VIII of this Amendment describes the alleged invention of Park as a steering wheel cover intended to reduce the effects of impacting the steering wheel. To the extent the steering wheel cover of Park is grasped by the driver, it may have some softness based on the cavity within the steering wheel cover being filled with air, a liquid, or a solid elastic material. There is nothing within the four corners of Park that would be inherent to lead one skilled in the art to understand the steering wheel cover of Park would provide "resting support" for the driver. To the extent the driver is grasping the steering wheel cover of Park, he/she would have their

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<sup>2</sup> Attachment A.

hands around the steering wheel cover squeezing it, which would not be resting support according to the present invention. Further, there is nothing in Park to support that it would be deformable out of interference with the operation of the vehicle as claimed in the present application.

Noting the above, Applicant has demonstrated that neither Anson, Gemma, or Park teach, suggest, or render obvious the "resting support" feature of the claims of the present invention. Accordingly, Applicant has refuted the Examiner's contention "resting support" is an inherent feature of Anson, Gemma, or Park.

## **XI. CONCLUSION**

Claims 20-29 are pending in the present application. Herein, Applicant has traversed the Examiner's objection to this specification, and the rejection of claim 29 for indefiniteness under 35 U.S.C. § 112, second paragraph, the rejection of claims 20-26 and 29 for anticipation under 35 U.S.C. § 102(b) based on Anson, the rejection of claims 27 and 28 for obviousness under 35 U.S.C. § 103(a) based on Anson taken with or without Gemma, the rejection of claims 20 and 27, and claim 28 for anticipation under 35 U.S.C. § 102(b) based Gemma, the rejection of claim 20 for anticipation under 35 U.S.C. § 102(b) based on Park, the rejection of claims 20-26 and 29 under the judicially created doctrine of obviousness-type double patenting based on claims 14-17, 24, and 27 of the co-pending 306 Application, and the rejection of claims 27 and 28 under the judicially created doctrine of obviousness-type double patenting based on claims 18 and 19/18 of the 306 Application. Having traversed the objection and each of the rejections, the present application is in condition for allowance.

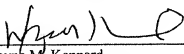
The present invention is new, non-obvious, and useful. Reconsideration and allowance of the claims are respectfully requested and application be passed to issue in due course.

Applicant includes a Petition for One-Month Extension of Time and payment of the fee. The Director is hereby authorized to charge Deposit Account No. 08-0219, under Order No. 0114089.120US2, the amount of \$65.00 for the one-month extension of time.

Applicant believes no fee is due with this Amendment. However, if there is a fee due, please charge Deposit Account No. 08-0219, under Order No.: 0114089.120US2 from which the undersigned is authorized to draw.

Respectfully submitted,

Dated: February 24, 2010

  
\_\_\_\_\_  
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## Attachment A



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,821	11/24/2003	Douglas B. Wilson	114089.120	5355

23483 7590 09/14/2009  
WILMERHALE/BOSTON  
60 STATE STREET  
BOSTON, MA 02109

EXAMINER
LUONG, VINH

ART UNIT	PAPER NUMBER
3656	

NOTIFICATION DATE	DELIVERY MODE
09/14/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com  
teresa.carvalho@wilmerhale.com  
sharon.mathews@wilmerhale.com

WILMER CUTLER PICKERING  
HALE and DORR LLP DOCKETING

RE: 114089.120.52

Action Date: \_\_\_\_\_

Action to be Taken: \_\_\_\_\_

Docketed By: *gag* On: 9-14-09



1 RECORD OF ORAL HEARING  
2  
3 UNITED STATES PATENT AND TRADEMARK OFFICE  
4

5  
6 BEFORE THE BOARD OF PATENT APPEALS  
7 AND INTERFERENCES  
8

9  
10 *Ex parte* DOUGLAS B. WILSON  
11

12  
13 Appeal 2009-005608  
14 Application 10/720,821  
15 Technology Center 3600  
16

17  
18 Oral Hearing Held: August 13, 2009  
19

20  
21 Before LINDA E. HORNER, JOHN C. KERINS and MICHAEL W.  
22 O'NEILL, *Administrative Patent Judges*.  
23

24  
25 ON BEHALF OF THE APPELLANT:  
26

27 WAYNE M. KENNARD, ESQUIRE  
28 Wilmer, Cutler, Pickering, Hale and Door, LLP  
29 60 State Street  
30 Boston, Massachusetts 02109  
31

32  
33 The above-entitled matter came on for hearing on Thursday, August 13,  
34 2009, commencing at 1:31 p.m., at the U.S. Patent and Trademark Office,  
35 600 Dulany Street, Alexandria, Virginia, before Dawn A. Brown, Notary  
36 Public.

PROCEEDINGS

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3

4

THE USHER: Calendar number 59 and Calendar Number 60,  
Mr. Kennard.

5

JUDGE HORNER: Good afternoon, Mr. Kennard.

6

MR. KENNARD: Good afternoon. How are you?

7

8

JUDGE HORNER: Do you happen to have a business card you can  
provide to the court reporter?

9

MR. KENNARD: I do, Your Honor.

10

COURT REPORTER: Thank you, sir.

11

12

MR. KENNARD: I'd like to introduce Doug Wilson, who is the  
inventor, and his wife Pamela Wilson.

13

JUDGE HORNER: Thank you.

14

15

16

17

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20

MR. KENNARD: For ease and convenience, I've put together -- these  
are just the pertinent parts of the record and talking about the references at  
issue. And I've also provided an even shorter-hand version, which has  
Mr. Wilson's invention of the two patents at issue and also the references, how  
they were described by the examiner in applying to portions. I've only used  
one of them since the three anticipation rejections are the same for both the  
'306 and the '821.

21

JUDGE HORNER: And this is information that is in the record?

22

MR. KENNARD: This is all in the record, yes.

23

JUDGE HORNER: Okay.

24

25

MR. KENNARD: It is just the -- and I will go through -- if you look at  
it, Your Honor, it is just Mr. Wilson's figure 3 and 4 and the claim 20, which is

1 the only independent claim. The second page is claim 14, the only  
2 independent claim.

3 Next is the first reference, Van Arsdel, and this is from the record from  
4 the examiner where he indicated the first and second section. The Anson  
5 reference, the same type of information, and followed by the Laubach.

6 JUDGE HORNER: Since the art is the same in both cases, what we  
7 thought we would do is have you -- if you'd like, you can present sort of both  
8 cases together in 40 minutes instead of doing one case in 20 and then the other.  
9 Is that okay with you?

10 MR. KENNARD: I was hoping that would be the case.

11 JUDGE HORNER: That is fine. And then we'll put a transcript in each  
12 record of the same transcript.

13 MR. KENNARD: Thank you very, very much.

14 To get started, I would like to -- sometimes a visual is better than many  
15 things. This is what we're talking about with Mr. Wilson's invention. And we  
16 put it on the steering wheel but it would be secured.

17 If you look at the first page of -- the PowerPoint is very easy -- where it  
18 shows figures 3 and 4, when this is fixed and you're driving, your hand would  
19 rest on here. It rests and is supported. And that, as we talk about, is a first  
20 section that attaches. The second section, which extends from the first section  
21 at an angle to the plane, your hand rests on here.

22 Well, what happens, as we all do, when we have an emergency  
23 situation, somebody stops forward, which is the invention we're looking at.  
24 What can you do with this? You grab it and look exactly what it does.

25 The support that it had, you've gone beyond deforming pressure and



1           you're able to grab the wheel, to securely grab it, so you can properly  
2   operate the vehicle.

3           And you're sitting there again as you're riding along, hand rests, it  
4   provides the medical benefits, which that is not part of this, but so you don't  
5   get fatigued. But something happens, once again, you can grab it.

6           And that is why sometimes -- if I may approach?

7           JUDGE HORNER: Yes.

8           MR. KENNARD: So you don't think it is lawyers doing this. If  
9   someone would grab that, you can see if your hand is resting and you pull, it  
10   will actually -- you can rest it there.

11          JUDGE HORNER: Okay.

12          MR. KENNARD: The two cases that you have before you, there is  
13   common interest as Your Honor did provide and it has to do with the  
14   anticipation rejection under 102.

15          Under 102, the standard is going to be one in which a single reference  
16   must add each and every element in the same way for there to be an  
17   anticipation of rejection. That is common to both cases -- I'll call it the '821  
18   and the '306, if you don't mind the shorthand.

19          The second issue goes to the '306 case, which looking at the claim 14, is  
20   where we have rigid, semirigid, deformable and inflexible in that claim.

21          JUDGE O'NEILL: Counsel, it would probably be easier for us if you  
22   would refer to the two cases, not by their serial numbers, because we'll start to  
23   get confused, but maybe by -- you've argued them as groups, so you have  
24   claim 20 in one case and then claim 14 in the other case. And that would help  
25   with how we kind of see them.

1 MR. KENNARD: Okay.

2 JUDGE HORNER: We use appeal numbers rather than the serial  
3 numbers up here, so we don't always reference them by their application  
4 numbers.

5 MR. KENNARD: You want me to use the appeal number? I will do  
6 that.

7 JUDGE HORNER: That would be fine.

8 JUDGE O'NEILL: If you can.

9 MR. KENNARD: If I say the 0506 and the other is the 1868.

10 The second one, the 1868 case is one in which there is the second issue,  
11 and that is the indefinite issue of the use of the terms rigid, flexible, semirigid  
12 and deformable.

13 If you notice the filing dates of these two cases, they are within a couple  
14 of weeks. The first was filed, and that was the 5608 case. And then  
15 Mr. Wilson recognizing that there may be a new-matter issue of adding the  
16 information of rigid, semirigid, flexible and deformable, those defining terms  
17 to the second section, the second CIP was added. So he wasn't trying to argue  
18 it. He said fine. He did that and that was provided in the --

19 JUDGE HORNER: You're referencing rigid, semirigid or flexible and  
20 deformable, but the claim says nondeformable.

21 MR. KENNARD: That was corrected in the course of the --

22 JUDGE HORNER: Okay.

23 MR. KENNARD: -- in the prosecution.

24 JUDGE HORNER: Okay.

25 MR. KENNARD: The -- and when that change was made, it was not

1 to add new matter; it was for the purpose of making sure there was a clarity of  
2 the issue with respect to the first and second section and what applied to the  
3 second section.

4 JUDGE HORNER: The claim's appendix reads -- I think it is the old  
5 version of the claim. The claim's appendix to your brief reads nondeformable,  
6 so we were getting a little confused.

7 MR. KENNARD: Okay.

8 JUDGE O'NEILL: So it actually reads rigid, semirigid, flexible or  
9 deformable?

10 MR. KENNARD: Let me get the change of the claim. It was in -- I will  
11 find it, Your Honor. I will find what it is. It was cited in the 30 -- in the 16 --  
12 1568 case.

13 JUDGE KERINS: 1868?

14 MR. KENNARD: 1868. I am sorry.

15 JUDGE KERINS: That is fine. I just want to make sure we have the  
16 right one.

17 JUDGE O'NEILL: What is your serial number for your 1868 case?

18 MR. KENNARD: That is '306.

19 JUDGE HORNER: 10/727,306.

20 MR. KENNARD: When we cited --

21 JUDGE O'NEILL: When did you add that correction, do you know?

22 MR. KENNARD: That is what I'm getting out, Your Honor.

23 JUDGE O'NEILL: I mean, did you do it in an amendment of some sort?

24 MR. KENNARD: It was during the prosecution in an amendment.

25 JUDGE HORNER: Can you remember when?

1 MR. KENNARD: I'm looking at the response.

2 JUDGE O'NEILL: Give me a general month, year.

3 MR. KENNARD: Yes. I'm looking. It has nondeformable in the  
4 response dated June 12, 2006, that we filed.

5 JUDGE O'NEILL: Unfortunately, that was nonresponsive. Why was  
6 that held nonresponsive? So that didn't go in. Wait a second. No, it is --  
7 something was nonresponsive. Did they put that in?

8 JUDGE KERINS: Counsel, even in that paper, it continues to use the  
9 word nondeformable as well as an amendment after final that was filed after  
10 that.

11 JUDGE O'NEILL: So it has not been entered based on our electronic  
12 records. Even the amendment of January 2006 it was never changed. You  
13 added peripheral to the first section.

14 JUDGE HORNER: We were having a little trouble figuring out how  
15 the second section could be made of a nondeformable material but then later  
16 the claim requires it to deform, and if indeed you meant to say deformable  
17 here, that would make that issue go away and be clearer to us as to how -- it  
18 would make more sense if it were a deformable material.

19 JUDGE KERINS: That wasn't the examiner's specific 112 --

20 MR. KENNARD: No, it wasn't.

21 JUDGE KERINS: -- objection. But in our review of the case, we  
22 picked up on that and we're trying to determine if that raised a separate 112  
23 issue.

24 MR. KENNARD: Right.

25 JUDGE O'NEILL: I have nothing in the record here of that ever

1 being changed.

2 MR. KENNARD: I will find it. If I could complete the argument and  
3 then I will find it.

4 JUDGE HORNER: Absolutely.

5 MR. KENNARD: As to the issue -- with respect to the issue -- the  
6 indefiniteness matter, it was cited by the examiner that the terms that were  
7 used were indefinite, and he cited a number of references, case citations, the  
8 main one being Phillips, and we changed our position along the way. And  
9 we'll get to that. But I just want to frame the two issues that are before you.

10 I would like to address the anticipation rejection first. As I  
11 demonstrated and what the current form of claim 20 -- this is going to be in the  
12 first application, which is 5608, if I'm correct.

13 JUDGE HORNER: That is right.

14 MR. KENNARD: And 5608, it includes the first section, which again,  
15 as we've shown here, is attached to the steering wheel.

16 The second section, which we talk about, is going to be extending at an  
17 angle from the plane and as -- during prosecution it was raised the issue about  
18 the limitations with respect to the second claim. That precipitated the  
19 changing of the claim to provide for the issue of deforming pressure. When  
20 deforming pressure is provided, that would then cause it to form out of  
21 interference with holding the steering wheel.

22 This action was shown to the examiner during prosecution, and when  
23 we looked at the references, the three that you have, we looked at those of not  
24 providing what was under the standard of section 102 for anticipation.

25 If we look first at the Van Arsdel reference, and if you look, I think it is

1 going to be on page 3 -- page 4 rather of the little shorthand version, the  
2 examiner cited, if you see the first arrow going across, where the element  
3 which is shown at 2 where it contacts the wheel, he has shown as being the  
4 first section, what he has at 4.

5 I hope you can see it.

6 JUDGE HORNER: Uh-huh.

7 MR. KENNARD: That is what he says the first section. Then the  
8 second section he indicates is this second -- item 2, which he said has a  
9 concave surface of which a palm rests. The operation as articulated in the  
10 briefing, once that is put on, if you look at it in figure 6, it is in -- we feel that  
11 is in the plane of the wheel because it is going across the wheel on the interior  
12 portion.

13 And the examiner says the little tip, if you look where 4 goes up, he says  
14 that is where it is -- it provides a part of the second section that is -- that  
15 extends from the plane out -- you know, out of that plane. But that is not  
16 providing, what we say in the second section, support.

17 Further, if you look at the way this is constructed, when they screw, if  
18 you see screw 14, they tighten this down onto the wheel and it doesn't move.  
19 And the examiner argued that, well, you know, it can be moved, so that makes  
20 it deformable. To do that, you have to unscrew it. That is removing. That is  
21 not deforming. That is a physical act you have to take to unscrew it and move  
22 it.

23 And the only safe way you could do that -- I guess you could try --  
24 people drive with cell phones these days. I guess you could try to unscrew it  
25 while you're driving, but I think that would be outside of what this is talking

1 about doing. The movement of that would be something that is necessary to  
2 move it from one place to another, but that is an act of moving it, removing it  
3 and putting it in another location.

4 And so when we talk about -- again, here we are. And we try to use  
5 precise language and say when you have it here, it is resting. But when you  
6 have to put more than deforming pressure, it is going to bend that around so it  
7 is going to be safely used in those type of situations.

8 The second reference is Anson, if you turn to next page. This is a little  
9 bit different, but as we argued in the brief, it doesn't provide any type of  
10 support in and of itself. This is something -- if this were the wheel, we'll move  
11 it around here since we have to use it. It would be dangling down here. It  
12 dangles down and someone holds it supposedly to hold the wheel.

13 It states very clearly and unequivocal that the resting takes place  
14 because your hands are -- and I don't want to sit down in front of Your  
15 Honors -- but it is -- it says you put your hands -- tells you you put your hands  
16 in your lap and that provides the resting, and you hold on to this dangle.

17 That dangle then is -- I don't know if I want to use it or not, but the  
18 dangle is supposedly there, but it doesn't provide support. It says clearly it is  
19 the lap that provides the resting portion for your hands.

20 JUDGE O'NEILL: What about your fingers?

21 MR. KENNARD: Well, I think you'd be doing just the opposite. If  
22 you're looking to relax your hands and wrists, grabbing and holding is not  
23 relaxing.

24 JUDGE O'NEILL: Well, your claim just requires a second section for  
25 supporting at least a portion of the vehicle operator's body. So it could be a

1 finger, could it not?

2 MR. KENNARD: Supporting a finger?

3 JUDGE O'NEILL: Yes. It is a part of a vehicle operator's body, isn't it?

4 MR. KENNARD: I'm saying you have to grasp though. This is  
5 supporting; this is grasping.

6 JUDGE O'NEILL: Well, it looks to me that the wheel attachment is  
7 kind of an oblong, maybe egg shape, and it is made out of a rubber-type  
8 material. That the friction along with that oblong egg shape would allow you  
9 just to have your fingers hold on.

10 I mean, there is some friction going on to just hold it in place just as  
11 similar as your wheel is of some sort of frictional material. If that was not a  
12 frictional material, wouldn't your hand just slide right off of it?

13 MR. KENNARD: Here? If it is here?

14 JUDGE O'NEILL: Wouldn't your hand, if that was made of a  
15 frictionless material, wouldn't your hand just slide right off of it?

16 MR. KENNARD: Like this?

17 JUDGE O'NEILL: Yes. It wouldn't maintain some support.

18 MR. KENNARD: It wouldn't maintain support then.

19 JUDGE O'NEILL: Right.

20 MR. KENNARD: If this --

21 JUDGE O'NEILL: I'm saying basically that the materials disclosed in  
22 Anson and the material that appears to be what you're invention is made of are  
23 pretty much similar and that there is some frictional force that is assisting in  
24 the support. It is not just the structure itself.



1 MR. KENNARD: There is support provided. It can be something on  
2 here or it could be integral with the wheel.

3 JUDGE O'NEILL: But I'm just having difficulty seeing why the Anson  
4 reference doesn't in some shape, way or form because of its shape and because  
5 of its materials that are being used to fabricate it that it doesn't provide some  
6 support to some body part.

7 MR. KENNARD: In my reading, Your Honor, they talk about what is  
8 provided, and they talk about the lap, and I'm reading what the spec said and  
9 this is what the disclosure of Anson talked about. And I cited to it within the  
10 appeal brief that what -- the resting part is caused by the lap.

11 JUDGE O'NEILL: Maybe you'd like to move now into what really  
12 seems the issue between yourself and the examiner -- not what is expressly or  
13 explicitly disclosed in the reference, but what is inherently disclosed in the  
14 reference.

15 And maybe this is now getting into that portion of what is inherently  
16 disclosed in the reference and what is your burden to show if the examiner  
17 says that something is inherently disclosed. What is your burden and have you  
18 met that burden?

19 MR. KENNARD: Inherency is that if there is a reference and there is --  
20 if inherently that would carry it out as one of skill in the art would understand,  
21 then that cannot be a distinguishing feature for purposes of patentability.

22 I think the inherent -- in looking at what you're mentioning. If, in fact,  
23 the inherent nature -- this is the dongle -- I'll just call it the dongle -- in Anson  
24 were to be the resting area and resting of hands, you would not -- let's move it

1 to the top. We'll move it to the top. And we're holding up there. Would it be  
2 causing a situation where you have the resting of the hands?

3 And the resting as they indicate to me in order to, one, at the base -- and  
4 I don't think it is inherently resting in this case of Anson because you want to  
5 hold this thing to hold the wheel. You're holding this. You're resting your  
6 arms but they're saying you're going to control the car with the dongle.

7 Here, when we're holding this we're resting our wrist, but we're -- we're  
8 resting our wrists but we're holding on with your fingers.

9 JUDGE KERINS: Counsel, in your invention when you're resting your  
10 wrists there, surely you're going to have some movement of the wheel back  
11 and forth that won't require you to actually deform and grip the wheel; isn't  
12 that correct?

13 MR. KENNARD: That is correct. But you are resting -- it is the not the  
14 lack that is causing it; it is the unit. The second section is causing the resting  
15 effect to take place.

16 If you look at the dongle, this dongle is one you have to hold and you're  
17 sitting like this, and I'm trying not to be informal. You're resting and you're  
18 holding the dongle supposedly to control the car.

19 The lap itself is the one that is providing -- if we were trying to equate  
20 the two, it is not the device that is doing it; it is the lap that is causing what is  
21 happening in the second section, not the dongle.

22 JUDGE KERINS: Counsel, we also in the anticipation arena where I  
23 believe the claim language we're discussing here is pretty much functional  
24 language, isn't it true that the prior art only needs to be capable of performing  
25 that function?

1 MR. KENNARD: And that is why I say -- and take the capability issue.  
2 If, in fact, you move -- and that is why I said let's move the dongle up top.  
3 And is it capable of doing it where it is going to be independent of the lap?  
4 Then you have nothing -- there is nothing to rest. From the use of that, it is not  
5 inherent that that is going to provide anything.

6 The other part is --

7 JUDGE KERINS: Counsel, isn't it supporting the hand when you have  
8 the dongle at the top? Isn't that supporting the hand?

9 MR. KENNARD: It is support but it is not providing any type of resting  
10 effect, which is provided by the lap. The lap is clearly what provides it, and if  
11 it is moved to the other place, it is not doing it.

12 The other is if you use the dongle, and I think it is argued that you can  
13 move it anywhere, you're going to be -- the way this is structured -- and it  
14 would be sitting here and you'd be reaching through here to try to use this  
15 under the construction they talk about. This will be the Anson dongle.

16 JUDGE HORNER: So are you interpreting the word "supporting" in  
17 your claim to mean some sort of resting on as support rather than supporting,  
18 for example, by hanging from?

19 MR. KENNARD: From the second section. We're talking about  
20 support for the second section, which is the resting effect, which is here for the  
21 wrist. The wrist is sitting here. Your fingers are on the wheel, but the resting  
22 effect is there, and you can do this when it happens.

23 JUDGE HORNER: But your claim says the second section for  
24 supporting a portion of the operator's body, not a second section adapted to  
25 allow the operator's body to rest on that piece. And we're saying there is a

1 difference between supporting and what you're talking about as resting.

2 Is there anything in your spec that defines supporting so that we would  
3 narrowly construe it to mean resting on rather than, for example, hanging  
4 from?

5 MR. KENNARD: In the spec, we talk about the relieving function. Let  
6 me look at the spec now. But that is what it provides on the second section.

7 JUDGE O'NEILL: I see at the very end there is a second embodiment  
8 that mentions this thing may be a single structure with a single resting material  
9 support, a single structure with multiple resting supports and multiple  
10 structures with their own resting support. Page 6 of your spec.

11 MR. KENNARD: That is the resting support we're talking about.  
12 Thank you, Your Honor.

13 JUDGE O'NEILL: So you want us to narrowly construe this to that  
14 second --

15 MR. KENNARD: The intent of a second section is a resting support.  
16 That is what it does. And that is what -- when we say deforming pressure  
17 when supporting the hand, it is the resting support it provides. And that is --  
18 well, the preamble can't be read, but it is fatigue-relieving. It is that support  
19 from sitting there. And this, when you have to do it, it changes when you have  
20 to grab the wheel.

21 JUDGE O'NEILL: Where was this argued in the brief? I see you've  
22 cited to the particular lap aspect, but the argument appears to be -- basically,  
23 the argument appears to be the little dongle just wouldn't be in use during an  
24 emergency situation. You'd grab the steering wheel.

25 MR. KENNARD: If in --

1 JUDGE O'NEILL: It wouldn't perform as set forth in claim 20, the hand  
2 grip would not perform as set forth. So I don't even see where all of this  
3 resting has even been argued except for right now before us.

4 MR. KENNARD: Your Honor, the resting support, it wasn't argued in  
5 the brief. It was raised now, and during the prosecution, discussion back and  
6 forth was the operation of either of the three references, which were Anson,  
7 Van Arsdel and Laubach.

8 JUDGE O'NEILL: Well, we're not dealing with method claims; we're  
9 dealing with an article claim at least in these two cases before us. Where is  
10 use coming in on this? Use is kind of a process.

11 MR. KENNARD: The use you're talking about, the resting support?

12 JUDGE O'NEILL: Well, it looks like your arguments are to the use and  
13 the art wouldn't be used. And as Judge Kerins said, in the anticipation arena it  
14 either can be expressly disclosed or it is capable of being used in a manner and  
15 it would read on the claim. It doesn't have to be used in that manner.

16 MR. KENNARD: And the resting -- and I think as was raised earlier,  
17 the dongle -- the capability of the dongle being in and of itself used as resting  
18 support, we did not see it doing that. We saw the gripping of it, but its  
19 reference talks about the lap being the place where the support is provided.

20 JUDGE O'NEILL: That is what Judge Kerins said, well, as long as it  
21 could be capable of doing it, it doesn't necessarily have to expressly state and  
22 that is where Judge Kerins talked about it was capable of supporting the hand  
23 because that is what we see in the claim is support. We don't see rest.

24 And now you're asking us to interpret this claim in a manner that  
25 focuses on a second embodiment that is at the very end of a specification. Is

1 that how you're asking us to interpret this claim now? Where you didn't ask  
2 that -- it doesn't appear you asked that in the brief, and I don't know if you've  
3 asked that before the examiner.

4 MR. KENNARD: That was not raised during prosecution specifically,  
5 Your Honor.

6 JUDGE O'NEILL: Okay. So we're supposed to give the claims the  
7 broadest reasonable interpretation in light of the specification and not limit it  
8 to just one particular embodiment.

9 MR. KENNARD: I understand that, Your Honor.

10 JUDGE O'NEILL: I think that what actually -- when we reviewed the  
11 record, what seemed to be really the major issue between you and the  
12 examiner is actually the very last portion of claim 20 that deals with the  
13 deformation of -- the deforming out of interference and that you appear to have  
14 said, well, even if -- just for argument sake there might be some inherency  
15 going on here, we'll prove to you that it cannot do it.

16 And so we would like you to go through each reference and maybe  
17 explain to us why there are three 102s and why they are not capable of  
18 performing the second section's function. We are assuming the examiner did  
19 make the prima facie case of anticipation and invoked the idea of inherency, as  
20 such the burden shifts to the appellant to come up before us or before the  
21 examiner and show that the prior art does not have this inherent feature.

22 And it seemed to be that that inherent feature that the examiner was  
23 relying on pointing to was the deformation out of interference. So what can  
24 you say with the three references -- in each reference that would show to us --  
25 satisfy us that each of these three references is incapable of performing

1 that functional language of deforming out of interference?

2 MR. KENNARD: Starting with Van Arsdell, that reference when  
3 screwed in place does not deform out of interference.

4 And we'll take Anson since that is the last one. If you look at -- again,  
5 you go to the Laubach, it has screws that go through the steering wheel and it  
6 will not deform out of interference, the use of the dongle deforming out of  
7 interference.

8 And when we looked at the reference trying to figure how that would  
9 happen is that you're holding -- if you're holding the dongle at the bottom -- I  
10 mean, where it is disposed and shown disposed, the grabbing of the wheel  
11 would be, we believe, that you'd grab the wheel.

12 I mean, if something happens you grab the wheel. It doesn't show  
13 where you would grab over the dongle to try to be -- inherently go out of  
14 interference.

15 The dongle is in a place where if you're holding it -- I'm assuming your  
16 hands are on top of each other if that is the case, or one hand and you would  
17 grab the wheel we would guess somewhere on the side to get control of the  
18 car. And we did not see where it would be inherent that that would be moving  
19 out of interference.

20 We tried to put it in a position and that is when we tried to argue where  
21 it would be in a position to do that. I mean, if you grabbed that, you would be  
22 looking for an inherency issue. And that would be if it was at the top because  
23 that is where you would be grabbing the wheel as we understand.

24 Because what they talk about in the reference Anson, they talk about  
25 you move -- where you normally hold it, you move your hands to the bottom

1 for the resting portion on your lap, and that is why we didn't see where it had  
2 the inherent nature of the moving out of interference if you had to grab the  
3 thing in an emergency situation.

4 JUDGE O'NEILL: Okay. So what I heard from you with the first two  
5 references, you identified some clear structural mechanisms that would --  
6 could possibly defeat the inherency position that the examiner has set forth.

7 And for the Anson reference you've argued its use or how it is used or  
8 where it is located, basically. And your position is that the operator would not  
9 be using it. He would be grabbing the wheel.

10 MR. KENNARD: We're looking at -- and I understand your question is,  
11 is it capable of doing it? And I think you are asking -- this is Judge Kerins  
12 said is it capable of doing it. We didn't see it was capable because we tried --  
13 in looking at what the reference taught and where the reference teaches you  
14 about this dongle, the dongle being -- is disposed below the steering wheel. It  
15 is the only place it said dispose of.

16 You can -- again, you can remove it and put it someplace else. And  
17 we're trying to figure where that is because they talk about to be able to move  
18 and hold the wheel in a driving position, and I assume going straight. I don't  
19 know. It would be very difficult to turn. I don't know how they'd do it. But  
20 the point is, it is sitting down here in your lap. That is the only disposition we  
21 see of it.

22 And the holding of the wheel was never associated with that dongle. At  
23 least in the first two mentioned, those being Van Arsdel and Laubach. There is  
24 association of the wheel and the unit. In the Van Arsdel, at least you're  
25 holding the wheel. In the other, they have the two things which you're



1 holding out here which is associated with the wheel.

2 The third one is the hands are disposed away from the wheel and not  
3 associated with it. And the grabbing of the wheel seems to be nowhere  
4 associated with that dongle. They talk about moving from the 10:00 and 2:00  
5 position down to the bottom.

6 JUDGE HORNER: In an emergency if you were to grab the wheel right  
7 around where this dongle is attached to the wheel, wouldn't it deform out of  
8 your way just by virtue of the material it is made from?

9 MR. KENNARD: It may.

10 JUDGE O'NEILL: Couldn't -- if you had to do really a hard turn to the  
11 left and a hard turn to the right, you would eventually grab hold of it? Say you  
12 were making a U-turn or something, you have to turn the wheel once or twice  
13 around. Wouldn't it --

14 MR. KENNARD: You mean if you're spinning the wheel around?

15 JUDGE O'NEILL: Not if you're spinning the wheel around but  
16 something similar to that, yes. If you're going hand over hand in turning the  
17 wheel around, by its materials that it is made out of deform out of interference  
18 with your ability to operate the steering wheel when pressure applied?

19 MR. KENNARD: I don't think it is you grabbing it; I think it deforms  
20 period. It is -- the material it is made of, you wouldn't deform it; it would just  
21 deform. They talk about -- you know, you are moving your hand, they talk  
22 about using it, being pliable. If you moved it around, it wouldn't be you  
23 deforming it; it would deform by itself.

24 JUDGE O'NEILL: I believe Anson says that the material is pliable

1 and semirigid. So it has some rigidity associated with it. I don't think it just  
2 flops around.

3 MR. KENNARD: Well, they say it is a bulbous rubber material and  
4 they have -- I think if they -- the way they talk about it used, it will move. It is  
5 meant to move.

6 JUDGE KERINS: Counsel, you had given a situation in an emergency  
7 you would let go of the dongle and grab the steering wheel. I understand what  
8 you're saying there. Suppose you then start turning the wheel and because the  
9 dongle is sitting down in the lap portion that the dongle ends up hitting your  
10 thigh.

11 Would your body not then be deforming the dongle as you're turning the  
12 wheel to deform it out of interference with your thigh?

13 MR. KENNARD: It wouldn't be gripping the wheel. It may move and I  
14 think deforming pressure when you're grabbing -- if you're grabbing and  
15 deforming pressure on that, it may move to the left or right, say it hits your leg  
16 if it is laying down.

17 But it is not moving out of interference with you grabbing the wheel. It  
18 moved -- your leg will move it, but that is not moving out of interference so  
19 you can grab the wheel.

20 JUDGE KERINS: So it has to be the same body part that is resting at  
21 one point and deforming at another part?

22 MR. KENNARD: It is -- the part that we believe is the part that is  
23 being -- you're correct. It is so that if you're resting on something, you grab  
24 the wheel, you can grab the wheel over that unit so that it will deform out of  
25 interference.

1           And that is -- and a good example of this is if you think about the old  
2     suicide nobs that used to be on -- that is something that sits out from the wheel.  
3     You could rest your hand on that. But if you ever had to grab, that is going to  
4     hit.

5           And so the issue, getting back to your specific issue, and that is the  
6     hitting your leg. Interference -- your leg is not the one driving the car; it is  
7     going to be your hands when you grab it.

8           JUDGE O'NEILL: But your claim just asks for it to be formed out of  
9     interference with the vehicle's operator ability to operate a steering wheel.

10          Now, surely, going back to Judge Kerins' hypothetical, it being the inner  
11     thigh knocking it out of the way, surely that -- and it deflecting as we kind of  
12     all agreed to, I believe, would deform out of interference with the vehicle  
13     operator's ability to operate the steering wheel because if it didn't, then you'd  
14     have this dongle hit your thigh and you couldn't turn your steering wheel.

15          MR. KENNARD: The -- if it was a stiff dongle? If the dongle was  
16     stiff?

17          JUDGE O'NEILL: Right. If it couldn't deform out, if it was a stiff  
18     dongle -- and giving Judge Kerins' hypothetical of having to grab it like you  
19     said at 10:00 and 2:00 and having to turn the wheel to the left or to the right, it  
20     would hit your inner thigh.

21          And if it didn't have any capability of deforming out of interference, it  
22     would then preclude the operator to operate the steering wheel because your  
23     thigh would block it. You couldn't turn it any farther.

24          MR. KENNARD: The thigh -- take the assumption -- Judge Kerins'  
25     assumption you have a stiff -- it is stiff versus pliable.

1 JUDGE O'NEILL: Right.

2 MR. KENNARD: In hitting your leg about deforming out of  
3 interference with the wheel, it is, we believe, the hands that are providing  
4 being rested would be the ones that should grab the wheel.

5 They are consistent with we have never changed -- this is what is  
6 provided and hopefully the claim is clear enough that if this is resting and this  
7 is going to bend out of interference of where your hand is resting, the thigh --  
8 contacting the thigh would not be, we believe in the context of that claim, out  
9 of interference. Because the thigh is not what is operating -- your operating  
10 ability of your hands if it is a stiff one, and they didn't talk about having a stiff  
11 one.

12 JUDGE O'NEILL: But it just says vehicle operator's ability. Doesn't  
13 limit it to hands or body parts. I don't see any limitation of body parts in this  
14 claim at all. I just see vehicle operator's ability to operate the steering wheel.

15 That is the key throughout this entire claim portion of the vehicle  
16 operator's body. I think there is no limits on having it held in hands. It could  
17 be any body part. It appears to be -- what appears to be stated.

18 MR. KENNARD: And the Anson reference, in reviewing it, it didn't  
19 talk about that type of structure. It was one to be pliable.

20 JUDGE O'NEILL: But again, I think the issue between you and the  
21 examiner has never been something what the Anson explicitly discloses; it has  
22 been what Anson could inherently disclose or is capable of doing. That  
23 appears to be the entire issue.

24 And so we are looking for something to -- some evidence to show that

1 Anson is incapable of performing this function in some way or manner, viz.  
2 deforming out of interference of the vehicle operator's ability to operate a  
3 steering wheel and pressure from the portion of the vehicle operator's body as  
4 applied to the second section is equal to or greater than the pressure deforming  
5 the second section out of interference with the vehicle operator's ability to  
6 operate the steering wheel.

7 MR. KENNARD: The reference -- the support that goes back, and this  
8 goes back to if I may talk about Anson again. Anson has an ability. It is  
9 flexible and it -- you're right, Judge Kerins. If you turn the wheel and it hits  
10 your leg, I assume it is going to be pliable. It is going to move. And I think  
11 we all agree it would move. We haven't challenged that from Judge Kerins.

12 The second issue is if we make it a stiff item, and that is the one that I  
13 think Judge O'Neill, you're saying, if it is stiff, would that make a difference?  
14 If I'm correct.

15 JUDGE O'NEILL: Right.

16 MR. KENNARD: If it is stiff and you turn and it hits your leg, and that  
17 would be one which would interfere with your ability to steer the car. Am I  
18 correct?

19 JUDGE O'NEILL: Correct.

20 MR. KENNARD: That is what you're saying. So if we look at the  
21 pliable version of Anson, then if you turn the wheel and it moves, then that is  
22 moving out of interference with -- am I framing that correctly? I just want to  
23 make sure.

24 JUDGE O'NEILL: Right. You're framing it correctly.

25 MR. KENNARD: As we see the situation with Anson, it is not just

1           the -- the inherency issue you're talking about goes to not only that one  
2 issue, but it also goes to how it is used -- not used but how they describe the  
3 structure, its operation in there and the resting portion, which we talked about  
4 earlier. I think we have to put it all together. The hands grip the bulb and say  
5 it is pliable and the rest is provided by the arms on the lap.

6           And that -- when you do that, that would be holding it, and the  
7 inherency issue inherently moving, hitting the leg, is not as we see the same as  
8 what we're talking about where we're talking about if the inherent feature of  
9 one of the others is it would move if you grabbed it because you're actually  
10 associating the unit or the device of the hand.

11           And that is where we see the difference between the two. Because  
12 Anson is sitting down below in a location that is different from associating  
13 directly with the wheel.

14           JUDGE HORNER: I think we've got your arguments. We're running a  
15 little short on time. If you want to just wrap up briefly and then we'll see if  
16 there are any more -- do you have another question?

17           JUDGE O'NEILL: He has the 112. Have you gone over the 112?

18           JUDGE HORNER: Do you want to touch on the 112 just briefly? I  
19 mean, we've got your arguments from the brief, but if you've got anything you  
20 want to add.

21           MR. KENNARD: What we provided with the arguments on the 112  
22 issue is -- as I said, we filed this second case, which is the 1568, if I am  
23 correct.

24           JUDGE KERINS: 5608.

25           MR. KENNARD: I'm sorry. In that -- when we added --

1 JUDGE KERINS: No, I'm sorry. 1868.

2 JUDGE HORNER: 1868.

3 JUDGE KERINS: I apologize.

4 MR. KENNARD: What we added -- in that reference, what we're  
5 talking about rigid, semirigid, flexible and deformable. We'll get to that issue.  
6 They weren't meant to be common terms used when someone wouldn't  
7 understand the art. We provided the dictionary definitions of them.

8 And also the Phillips case which was cited by the examiner talks about  
9 that and says if it is something a layperson would understand what those terms  
10 would be, that is sufficient for the descriptive portion of the claim.

11 We're not trying to say it is anything other than what a dictionary  
12 definition of those terms would be. He cited the 1969 case which says flexible  
13 is ambiguous, and the examiner cited it in his art. But we believe that in the  
14 context of what we described, the dictionary definitions do describe what this  
15 material is.

16 JUDGE O'NEILL: So you're basically -- you agree that your  
17 specification provides no explicit definition for these terms?

18 MR. KENNARD: No.

19 JUDGE O'NEILL: You don't have to say when we say rigid we mean  
20 this. That is an explicit definition.

21 MR. KENNARD: We did not say that.

22 JUDGE O'NEILL: You don't have that. And the words -- none of the  
23 words around these terms are going to kind of help us construe this language  
24 meaning? It is just -- you're just asking us to rely basically on the plain  
25 meaning found in -- that one of ordinary skill in the art -- that is what

1 one of ordinary skill in the art would understand that these terms mean.

2 MR. KENNARD: Yes, Your Honor. In the argument by the examiner  
3 back to us, it was, you know -- it started out what was a Rockwell number for  
4 the material and in which -- if it was a metal I could see what the Rockwell  
5 number would be. And then we changed a couple of times what he had in his  
6 argument and then came back with what is the objective test in the final  
7 iteration of the answer about objective tests and cited the Phillips.

8 But what we're citing to is it is the common understanding what you  
9 would know as semirigid. If you look at the dictionary definitions, one of  
10 ordinary skill or a layman would understand what those would be from the use  
11 in the specification.

12 JUDGE KERINS: Counsel, this wasn't raised by the examiner and we  
13 originally approached it from the language about nondeformable and how can  
14 it be nondeformable yet be deformable. Apparently you've said you'll try to  
15 fix that up in further prosecution. How about the word "rigid" though? If we  
16 have something that is rigid, how is it going to deform?

17 MR. KENNARD: It can deform. It can deform and I think we talk  
18 about this. This is the material here can be rigid. This is the second section.  
19 If at the first -- and we talk about the first section, this can be rigid and still  
20 bend down. You can still grab it. It is not going to fall all the way around, but  
21 you can still grab it in an emergency. And that is what we were getting to  
22 there.

23 And because we didn't want from the first application -- that is the  
24 5608?

25 JUDGE KERINS: Yes.



1 MR. KENNARD: I got it finally. That Mr. Wilson wanted to share that  
2 it could be other materials, explicitly other materials, and that being -- this  
3 could be rigid and it could be semirigid and it could be flexible, and that is  
4 where --

5 JUDGE KERINS: Counsel, this may not have an ultimate effect, but  
6 does that exclude anything -- rigid, flexible and semirigid? Is there anything  
7 excluded by reciting that that way?

8 MR. KENNARD: I haven't looked at it that specifically, and I would  
9 have to take that under advisement if it excludes anything, but he wanted to  
10 cover that it could be of other mixture. That it would be understood by  
11 someone reading it of the two patents that that would be -- or two applications  
12 that it could be of different materials.

13 And also it goes and explains within the second application the  
14 flexibility can be -- at the juncture in there if you read through the specification  
15 it talks about that, so that would apply.

16 JUDGE KERINS: Fair enough.

17 JUDGE HORNER: Any further questions?

18 JUDGE KERINS: Nothing more.

19 JUDGE HORNER: Thank you for your time.

20 MR. KENNARD: I'd like to thank you for your time and effort and  
21 letting me take some informalities of sitting down which is not normal in a  
22 courtroom.

23

24 (Whereupon, the proceedings at 2:26 p.m. were concluded.)